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| 09/823,626 | 03/30/2001 | David K. Braverman | COS99036 | 6953 |

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WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
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WASHINGTON, DC 20036

EXAMINER

LEROUX, ETIENNE PIERRE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2171

DATE MAILED: 03/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,626

Applicant(s)

BRAVERMAN, DAVID K.

Examiner

Etienne P LeRoux

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 5,991,750 issued to Watson (hereafter Watson '750).

Claim 1:

Watson '750 discloses a method for providing an on-line billing system, the method comprising:

- storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents [*account manager may be in charge of many accounts, col 6, lines 60-65*];
- generating a list of customer accounts corresponding to the particular agent from the account information [Fig 5, 504, col 7, lines 23-30]
- displaying the list via a web browser to the agent [inherent in personal computer and INTERNET, col 4, lines 61-66, Fig 5, 502].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 11, 16, 21, 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson '750 in view of US Pat No 6,616,458 issued to Walker et al (hereafter Walker '458).

Claims 6, 11, 16, 21, 26 and 32:

Watson '750 discloses a communication interface configured to retrieve account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents; and a processor coupled to the communication interface [abstract].

Watson '750 fails to disclose generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent.

Walker '458 discloses generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent [abstract]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Watson '750 to include generating a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent as taught by Walker '458.

The ordinarily skilled artisan would have been motivated to modify Watson '750 as above for the purpose of selecting customers which would respond to a survey [abstract].

5. Claims 2, 7, 12, 17, 22 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson '750 in view of US Pat No 5,724,584 issued to Peters et al (hereafter Peters '584).

Claims 2, 7, 12, 17, 22 and 27

Watson '750 discloses the elements of claims 1, 6, 11, 16, 21 and 26 as noted above.

Watson '750 fails to disclose drilling down to view a particular customer invoice associated with a particular customer account selected from the list.

Peters '584 discloses drilling down to view a particular customer invoice associated with a particular customer account selected from the list [claim 7].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Watson '750 to include drilling down to view a particular customer invoice associated with a particular customer account selected from the list as taught by Peters '584.

The ordinarily skilled artisan would have been motivated to modify Watson '750 as above for the purpose of accessing a particular business transaction.

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6. Claims 3, 4, 8, 9, 13, 14, 18, 19, 23, 24, 28, 29, 30, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson '750 in view of US Pat No 6,496,744 issued to Cook (hereafter Cook '744).

Claims 3, 8, 13, 18, 23, 28, 29, 33 and 34:

Watson '750 discloses the elements of claims 1, 6, 11, 16, 21 and 26 as noted as above.

Watson '750 fails to disclose providing automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation.

Cook '744 discloses e-mail order tracking information [abstract].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Watson '750 to include e-mail order tracking information as taught by Cook '744.

The ordinarily skilled artisan would have been motivated to modify Watson '750 as above for the purpose of improving the invention by providing a customer with order process updates so that the customer can plan to receive the product.

Furthermore, the ordinarily skilled artisan would have been motivated to modify the combination of Watson '750 and Cook '744 to include providing automatic receipt of an e-mail notification message to notify one of the plurality of agents of an event associated with the customer, wherein the event includes at least one of a new enrollment and an account cancellation for the purpose of providing a means for notifying a customer of the status of his/her account.

Claims 4, 9, 14, 19, 24 and 30:

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Watson '750 discloses the elements of claims 1, 3, 6, 8, 11, 13, 16, 21 and 23 as noted above.

Watson '750 fails to disclose selectively disabling the automatic receipt of the e-mail notification.

Cook '744 discloses enabling e-mail notification.

It would have been obvious to one of ordinary skill in the art to modify Watson '750 to include e-mail notification.

The ordinarily skilled artisan would have been motivated to modify Watson '750 to include enabling e-mail notification as taught by Cook '744.

The ordinarily skilled artisan would have been motivated to modify Watson '750 as above for the purpose of providing a means for notifying a customer of the status of his/her account.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Watson '750 and Cook '744 to include disabling e-mail notification for the purpose of removing e-mail notification to a person who is no longer a customer.

Claims 5, 10, 15, 20, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson '750 in view of Pub No 2001/0018673 issued to Goldbrand et al (hereafter Goldbrand '673).

Claims 5, 10, 15, 20, 25, 31:

Watson '750 discloses the elements of claims 1, 6, 11, 16, 19, 21 and 26 as noted above.

Watson '750 fails to disclose wherein the customer account in the storing step is associated with a user identification of the particular agent.

Goldbrand '673 discloses wherein the customer account in the storing step is associated with a user identification of the particular agent [paragraph 33]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Watson '750 to include wherein the customer account in the storing step is associated with a user identification of the particular agent as taught by Goldbrand '673.

The ordinarily skilled artisan would have been motivated to modify Watson '750 to include the above elements for the purpose of uniquely identifying the user.

Response to Arguments

Applicant's arguments filed 12/29/2003, have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant states on page 11, "The cited passage of col 7, lines 23-30 (Office Action, Page 2, lines 19-20) merely provides a definition of the term "account issuer" as an organization providing administrative services to an account user and a card company or authorizing agent. The account manger may also provide augmented services to an account user or manager such as access to an authorizing agent for account establishment and other functions such as pre-authorization. There is no suggestion or disclosure of 'generating a list of customer accounts corresponding to the particular agent from the account information' as recited by claim 1."

First Examiner Response:

Examiner is not persuaded. Examiner maintains that the following disclosure by Watson, col 4, lines 19-35, reads on above limitation:

A further advancement of the present invention provides a method and system for allowing an account manager to define a transaction identifier (e.g., insurance claim number, purchase order number, work order number, etc.) and attach the transaction identifier through a pre-authorization of a transaction. Upon the initiation and authorization of a requested transaction conforming to the specified pre-authorization parameters, the transaction identifier is included with the generic billing information (e.g., transaction amount, merchant information, etc.) thus allowing an account manager to reconcile their accounting from a billing account information containing the transaction having the transaction identifier associated thereto with a pre-transaction assignment of a traditional identifier such as purchase order number, work order number, or insurance claim number.

Furthermore, Watson discloses in Figure 5, 502 a display of multiple customer accounts.

Second Applicant Argument:

Applicant states on page 11, "In addition, the Office Action cites col 4, line 67 of Watson as disclosing 'displaying the list via a web browser to the agent.' (see Office Action, Page 2, line 21). However, this portion of Watson discusses an account manager that transfers pre-authorization parameters to a card issuer via the internet. The general disclosure of the 'Internet' is different from the specific feature of 'displaying the list via a web browser to the agent' of claim 1."

Second Examiner Response:

Examiner is not persuaded. Examiner maintains that the following disclosure by Watson, col 4, lines 60-67 reads on above limitation:

In the present invention, once an account is established with a card issuer, an account manager may perform pre-authorization of transactions with the card issuer directly. In the preferred embodiment, an account manager using a personal computer may routinely generate pre-authorization requests by transferring pre-authorization parameters to the card issuer via the INTERNET.

Furthermore, Watson discloses in Figure 5, 502 a display of multiple customer accounts.

Third Applicant Argument:

Applicant states on page 12, lines 8-16, "One of ordinary skill in the art of data processing would not be motivated by this disclosure to instruct display of the list of customer accounts to the controller (i.e. a computer) via a web browser, as the controller of Walker et al is a computer which receives a survey and may elect respondents from a list of customer accounts for transmittal of respondent questions. Walker et al thus teaches away from combining its disclosure with Watson for the feature 'a processor coupled to the communication interface and configured to generate a list of customer accounts corresponding to the particular agent from the account information, and to instruct display of the list via a web browser to the agent' as required by claim 6."

Third Examiner Response:

Examiner is not persuaded. Walker discloses the following in column 2, lines 1-10:

In accordance with the present invention, a controller such as an online service provider computer or an Internet Service Provider (ISP) computer receives a survey including survey questions from a client desiring to have a survey conducted. The controller creates respondent questions based on the survey questions. The controller also selects one or more respondents from a list of possible respondents, such as a list of customer accounts. The respondent questions are transmitted to the selected respondents. Responses corresponding to the respondent questions are received.

Examiner maintains that the following disclosure by Watson, col 4, lines 60-67 reads on above limitation:

In the present invention, once an account is established with a card issuer, an account manager may perform pre-authorization of transactions with the card issuer directly. In the preferred embodiment, an account manager using a personal computer may routinely generate pre-authorization requests by

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transferring pre-authorization parameters to the card issuer via the INTERNET.

As both Watson and Walker disclose the Internet and a web browser, it would have been obvious to one of ordinary skill in the art to combine the references to obtain generating a list of customer accounts as taught by Walker [abstract].

Fourth Applicant Argument:

Applicant states on page 12, lines 20-24, "With regard to the obviousness rejections of claims 2, 7, 12, 17, 22 and 27, Applicant respectfully submits that the deficiencies of Watson are not cured by the secondary reference of Peters et al., particularly with respect to 'generating a list of customer accounts corresponding to the particular agent from the account information; and displaying the list via a web browser to the agent.'"

Fourth Examiner Response:

Examiner is not persuaded. Examiner maintains that the following disclosure by Watson, col 4, lines 19-35, reads on the limitation 'generating a list of customer accounts:'

A further advancement of the present invention provides a method and system for allowing an account manager to define a transaction identifier (e.g., insurance claim number, purchase order number, work order number, etc.) and attach the transaction identifier through a pre-authorization of a transaction. Upon the initiation and authorization of a requested transaction conforming to the specified pre-authorization parameters, the transaction identifier is included with the generic billing information (e.g., transaction amount, merchant information, etc.) thus allowing an account manager to reconcile their accounting from a billing account information containing the transaction having the transaction identifier associated thereto with a pre-transaction assignment of a traditional identifier such as purchase order number, work order number, or insurance claim number

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Furthermore, examiner maintains that the following disclosure by Watson, col 4, lines 60-67 reads on the limitation 'displaying the list via a web browser to the agent:'

In the present invention, once an account is established with a card issuer, an account manager may perform pre-authorization of transactions with the card issuer directly. In the preferred embodiment, an account manager using a personal computer may routinely generate pre-authorization requests by transferring pre-authorization parameters to the card issuer via the INTERNET

Fifth Applicant Argument:

Applicant repeats the argument regarding generating a list of customer accounts.

Fifth Examiner Response:

Applicant is referred to above responses by examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.


The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

3/3/2004



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